

REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 8-19 were pending in this application. In this Request for Reconsideration, Applicant has not amended, canceled, or added any claims. Accordingly, claims 8-19 will still be pending after entry of this Amendment.

In the Office Action mailed January 9, 2009, the Examiner rejected claims 8-19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,359,265 to Thorne, Jr. et al. ("Thorne") and U.S. Patent No. 5,356,420 to Czernecki et al. ("Czernecki"). Applicant respectfully traverses that rejection. The following remarks are organized under subheadings corresponding to the rejected claims.

Claims 8 And 9

At page 3 of the Office Action, the Examiner appeared to equate both the extended rectangular guide bar 354 of Thorne and the breakable wing 11 of Czernecki with the at least one side jut recited in claim 8. However, both of those components lack the structural features of the side jut recited in claim 8.

Examples of a side jut of the present invention are shown as side juts 15, 16 on the puncturing needle 5 in Figures 1-4 of the present application. As shown in those figures, and recited in claim 8, each side jut is disposed inside the housing *between the at least one return spring and the second end of the driving spring*. Furthermore, as shown in Figure 4 and recited in claim 8, the at least one return spring *acts against the at least one side jut* in a direction generally opposite to the driving direction. By virtue of this position of the side juts and contact

by the return spring, the lancet 21 of the puncturing needle 5 is returned to within the housing 1. Thorne and Czernecki fail to teach or suggest those features.

In Thorne, the extended rectangular guide bars 354, 356 “ride in guides molded in housing 300 to assure linear displacement of blade 90’ during retraction and lancing.” (Col. 8, lines 46-49.) As shown in Figure 19, the bars 354, 356 of hub 352 are not disposed between the blade shield parts 420, 430 and the driving spring 350 when the needle 90’ is extended during puncturing. Therefore, the blade shield parts 420, 430 cannot, and do not, *act against* the bars 354, 356 in a direction generally opposite to the driving direction, as recited in claim 8. Instead, as explained in detail in the Remarks of the Amendment filed September 15, 2008 (incorporated by reference herein), Thorne specifically teaches that, at the end of the lancing cycle, the driving spring 350 (which is integrally connected to the blade 90’) recoils to retract blade 90’ into the housing 300, as shown in Figure 20 of Thorne. Therefore, the driving spring 350 – *not* the blade shield parts 420, 430 – returns the blade 90’ to the inside of the housing 300. Thus, Thorne fails to teach or suggest at least the feature of the at least one return spring *acting against* the at least one side jut in a direction generally opposite to the driving direction, as recited in claims 8 and 9.

At page 6 of the Office Action, in the Response to Arguments section, the Examiner dismissed the term “return” in claim element “at least one return spring” as a recitation of the manner in which a claimed apparatus is intended to be employed. That intended-use rationale, however, is inapposite and fails to recognize the further structural features recited about the at least one return spring. As explained above, claim 8 recites that the at least one return spring *acts against* the at least one side jut in a direction generally opposite to the driving direction. In that manner, the at least one *return* spring *returns* the puncturing needle to within the housing.

Taking that recited structure into account, the term “return” is not a recitation of intended use and is indeed a positive structural recitation of the invention – one that is distinguishable over Thorne as described above.

Regarding the Examiner's reference to “a side jut (11)” at page 3 of the Office Action, element 11 of Czernecki is not in fact a side jut, but rather a breakable wing. There are no return springs acting against that breakable wing 11. Rather, the breakable wing 11 rests against the internal projection 12 and is broken against that projection 12 when the push-button 2 is pushed sufficiently hard. (Col. 2, lines 24-38.) After the puncturing tip 7 passes through hole 4 in the bottom 3 of sleeve 1 and pierces the puncturing surface, the return spring 10 pushes the piston 5 back to withdraw tip 7. Neither the return spring 10 nor any other component could act against the wing 11 because it has been broken away. Thus, Czernecki fails to teach or suggest at least the recited at least one return spring acting against the least one side jut, and in that way fails to cure the deficiencies of Thorne.

Applicant therefore respectfully submits that claim 8 is patentable over the applied prior art. Applicant further respectfully submits that new dependent claims 9-19 are also patentable due at least to their dependence on an allowable base claim and for the additional features recited therein (discussed further below).

Applicant further respectfully traverses the Examiner's motivation for combining Thorne and Czernecki. It is unreasonable to assert that it would be obvious for a person skilled in the art to provide a device similar to that of Thorne and equipped with breakable wings according to Czernecki.

Czernecki states that the breakable wings ensure, first, that the puncturing tip is kept in a stable position until the push button is actuated by a force and, second, that the device cannot be re-used. The puncturing tip is kept stable before use due to the pressure exerted by the power spring 9, pressing the wings 11 of the piston 5 against the projection 12 of the sleeve 1. (Col. 2, lines 27-32.) After use, the device cannot be re-used because the wings 11 are broken off. (Col. 2, lines 43-44.)

In contrast, Thorne's puncturing device is based on a different operating principle, *i.e.*, the puncturing needle is actuated based on the following mechanical scheme: push button, driving spring, *arms of the push button, puncturing needle*. In Thorne's solution, the tip of the puncturing needle is not stable before the needle is actuated, because the needle is linked with the driving spring, which must be compressed to actuate the needle. In the puncturing device according to Czernecki, the puncturing needle is actuated based on the mechanical scheme: push button, driving spring, *puncturing needle, shield*.

Given these divergent teachings, there would be no motivation to combine Thorne and Czernicki. Applicants therefore respectfully submit that their combination is improper and respectfully requests withdrawal of the rejection of claims 8 for that additional reason.

Claims 10-13

Reading the features recited in dependent claims 10-13 in conjunction with those of independent claim 8, the Examiner's rejection of claims 10-13 is not justified. The Examiner refers to elements of the Thorne's puncture device, which elements cannot be considered equivalent to the elements of the present puncturing device, since it based on a different operating principle, as explained above.

In particular, Thorne does not teach the structural feature recited in claim 13 wherein the pusher *is separate from* the puncturing needle. In Thorne, the driving spring 350 is always integrally connected to the blade 90'. (See, e.g., Figure 20.) The Examiner's intended-use rationale for rejecting claim 13 is inapposite, as claim 13 positively recites that the pusher is separate from the puncturing needle ("wherein the pusher...separates from the puncturing needle after use").

For those additional reasons, Applicant respectfully submits that claims 10-13 are patentable over the prior art.

Claim 14

In rejecting claim 14, the Examiner cited Figure 23 and column 8, lines 35-36 as disclosing the recited pusher with a cup-shaped end and a puncturing needle fitting within the cup-shaped end. Those portions of Thorne, however, explicitly teach an integral actuator and blade assembly 320 as a single part. As such, the integral part could not have the discernible features of a cup-shaped end and a needle fitting within that cup-shaped end. Furthermore, contrary to the Examiner's stated motivation, there would be no motivation to modify the needle since it is integral to the entire part. For this additional reason, Applicant respectfully submits that claim 14 is patentable over the prior art.

Claims 17 And 18

Claims 17-18 recite further features related to the patentable features discussed above in reference to claim 8. For example, claim 17 recites that, upon breaking the breakable wings, the driving spring drives the puncturing needle such that a lancet of the puncturing needle extends outside the housing and *the at least one side jut contacts the at least one return spring*, and that,

after the lancet extends outside the housing, *the at least one return spring applies a second force to the at least one side jut* in a direction generally opposite to the first force to pull the lancet of the puncturing needle inside the housing. As explained above, in Thorne, the blade shield parts 420, 430 *cannot, and do not, contact or apply a force against* the bars 354, 356 in a direction generally opposite to the driving direction. Accordingly, for reasons similar to those set forth above in support of the patentability of claim 8, Applicant respectfully submits that claims 17-18 are patentable over the prior art.

Claim 19

In the Thorne device, the arms are integral with the push button only after the driving spring is compressed while the puncturing needle is actuated. Moreover, element 340, which the Examiner equated with the press button 3 of the present invention, is fixed against the shield 300, which results from a different operating principle of the Thorne device. If the arms 400, 410 of the Thorne device were to be permanently integral with the push button 340, as is the case in the present invention, the Thorne device would need to have a different construction allowing the driving spring to be compressed, *i.e.*, the push button 340 would need to be movable with respect to the shield 330. The puncturing device according to the present invention and the Thorne device therefore obviously have different constructions. For that additional reason, Applicant respectfully submits that claim 19 is patentable over the prior art.

Information Disclosure Statement Filed January 23, 2006

In the Amendment filed September 15, 2008, Applicant noted that the Examiner indicated consideration of the two U.S. patent documents listed on the Information Disclosure Citation Form PTO-1449 filed January 23, 2006, but did not acknowledge consideration of the

Serial No.: 10/565,395
Art Unit: 3731
Inventor: Włodzimierz RUTYNOWSKI

Attorney's Docket No.: POL0010-US
Page 11

associated International Search Report listed under the "Other Documents" section of that same form. Applicant respectfully requested that the Examiner provide such acknowledgement by initialing the form next to the listed International Search Report and including the fully initialed form in the next communication. The Examiner has not yet provided that acknowledgement. Applicant therefore renews the request. For the Examiner's convenience, Applicant has enclosed a copy of the PTO-1449 form with this Request for Reconsideration.

In view of the foregoing, all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative at the number listed below.

PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th Street, N.W.
Washington, D.C. 20005


Respectfully submitted,

Tel: 202/551-1700

WŁODZIMIERZ RUTYNOWSKI

Date: March 9, 2009

By:


Michael Bednarek
Registration No. 32,329

MB/SPA/ggb
Customer No. 36183

